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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,049	06/08/2001	Nino R. Vaghi	T3379-907561	9037

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EXAMINER

ELAHEE, MD S

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/876,049	Applicant(s) VAGHI ET AL.	
	Examiner Md S. Elahee	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 107, 108, 129 and 131-168 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 107, 108, 129 and 131-168 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed on 05/18/2006. Claims 107, 108, 129 and 131-168 are pending. Claims 1-106, 109-128, 130 have been previously cancelled. Claims 156-168 have been added.

Response to Arguments

2. The arguments filed in the 05/18/2006 Remarks have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 136 and 137 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 136 and 137, the phrase 'the wireless communications unit' on page 5 lacks sufficient antecedent basis because it appears that the phrase 'the wireless communications unit' should be 'the first wireless communications unit'.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 107, 108, 144, 156-158 and 160-162 are rejected under 35 U.S.C. 102(b) as being anticipated by Wenk et al. (U.S. Patent No. 6,253,088).

Regarding claim 107, with respect to Figures 1,2,5-9, Wenk teaches a telephone set, comprising:

a subscriber terminal 34' [i.e., first wireless communication unit] (fig.9);

a memory unit for storing activation information input through the keypad (col.5, line 46-58);

a personal base station 18 or 345 [i.e., hard-wired telephone] to receive calls from a land line at a first telephone number, the hard-wired telephone including a controller [i.e., processor] (fig.2, item 55) for automatically setting the first wireless communications unit to receive one or more calls from a wireless service provider, the processor automatically setting the first wireless communications unit to receive the calls based on a phone number of subscriber terminal 347 [i.e., second wireless communications unit] corresponding to a user's pre-existing mobile

telephone number, wherein the user's pre-existing mobile telephone number is entered through a keypad of the hard-wired telephone for access by the processor for automatically setting the first wireless communications unit (fig.1,9; col.5, line 46-58, col.9, line 53- col.10, line 7).

Claim 108 is rejected for the same reasons as discussed above with respect to claim 107. Furthermore, Wenk teaches a hard-wired telephone including a keypad and a transceiver (fig.1,9; col.5, line 46-58).

Regarding claim 144, Wenk teaches after setting the first wireless communications unit, the processor automatically transmits a signal to the wireless service provider to provide notification that the first wireless communications unit is available to receive calls based on the user's mobile telephone number of the second wireless communication unit (col.9, line 53- col.10, line 7). (Note; when a wireless device is turned on it automatically signals the provider for its availability of receiving calls.)

Regarding claims 156, 160, Wenk teaches wherein audio signals corresponding to the calls as received by the first wireless communications unit are output through a handset of the hard-wired telephone (col.9, line 53- col.10, line 7).

Regarding claims 157, 161, Wenk teaches wherein the first wireless communications unit, the memory unit, and said processor are included within a housing of the hard-wired telephone (fig.1,9; col.9, line 53- col.10, line 7).

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Regarding claims 158, 162, Wenk teaches wherein the first telephone number is a PSTN number (fig.1,9; col.8, lines 54-57). (Note: land line telephone 26 of fig.1 has PSTN number)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

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and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 129, 131, 132, 134-136, 138-141, 143, 164-166 and 168 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wenk et al. in view of Norman et al. (U.S. Patent No. 5,485,505).

Claim 129 is rejected for the same reasons as discussed above with respect to claim 107. Furthermore, Wenk does not specifically teach “a reader that reads information from a removable storage medium”. Norman teaches a reader that reads information from a PCMCIA [i.e., removable storage medium] (col.9, line 67-col.10, line 5, col.11, lines 8-14). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wenk to incorporate a removable storage medium for a reader that reads information from it in order to provide a flexibility of a telephone set to upgrade its memory.

Claim 131 is rejected for the same reasons as discussed above with respect to claim 129. Furthermore, Wenk that the reader reads a user identification code from the memory and wherein the processor compares the user identification code to a re-stored code to authorize receiving calls based on the mobile telephone number of the user (col.5, line 46-58, col.9, line 53- col.10, line 7).

Claim 132 is rejected for the same reasons as discussed above with respect to claim 129. Furthermore, Wenk does not specifically teach “the information stored on the removable storage medium includes a serial number used to authorize receipt of the calls”. Norman teaches the information stored on the removable storage medium includes an ESN [i.e., serial number] used to authorize receipt of the calls (col.5, line 46-58, col.9, line 53- col.10, line 7). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wenk to incorporate the information stored on the removable storage medium includes a serial number used to authorize receipt of the calls in order to provide a unique number that will be used for authorization of receiving particular calls.

Claim 134 is rejected for the same reasons as discussed above with respect to claim 129. Furthermore, Wenk teaches that the information stored on the memory includes information which the wireless service provider or a local exchange carrier needs to activate operation of a wireless phone (col.5, line 46-58, col.9, line 53- col.10, line 7).

Regarding claim 135, Wenk teaches a communications port to receive telephone calls through a public switched telephone network (fig.1,9; col.9, line 53- col.10, line 7).

Regarding claim 136, Wenk teaches that the telephone calls received through the public switched telephone network bypass the wireless communications unit (fig.1,9; col.9, line 53- col.10, line 7).

Regarding claim 138, Wenk teaches that the wireless communications unit is deactivated to allow calls to be received through the public switched telephone network when no removable storage medium is coupled to the reader (col.9, line 53-col.10, line 4).

Regarding claim 139, Wenk teaches a connector to connect the wireless communications unit to a remotely located antenna (fig.1,9; col.9, line 53- col.10, line 7).

Regarding claims 140, 143, Wenk does not specifically teach that the hard-wired telephone is located in a hotel room or in a kitchen appliance. Examiner takes official notice that the hard-wired telephone to be located in a hotel room or in a kitchen appliance are well known in the art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wenk to incorporate the hard-wired telephone' location in a hotel room or in a kitchen appliance in order to provide flexibility of using the telephone in different locations.

Regarding claim 141, Wenk teaches a keypad to enter a phone number to be dialed by the user based on the user's mobile telephone number of the second wireless communications unit to which the wireless communications unit is set by the processor (col.5, line 46-58).

Claims 164-166 and 168 are rejected for the same reasons as discussed above with respect to claims 156-158 and 129 respectively.

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10. Claim 133 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wenk et al. in view of Norman et al. further in view of McDonnell et al. (U.S. Patent No. 6,771,972).

Claim 133 is rejected for the same reasons as discussed above with respect to claim 132. Furthermore, Wenk in view of Norman does not specifically teach “the authorization information includes location information”. McDonnell teaches that the authorization information includes location information (col.6, lines 11-22). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wenk in view of Norman to incorporate the authorization information including location information as taught by McDonnell. The motivation for the modification is to have doing so in order to provide authorization for a particular location.

11. Claim 137 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wenk et al. in view of Norman et al. further in view of Bultman (U.S. Patent No. 6,804,536).

Regarding claim 137, Wenk in view of Norman does not specifically teach “the processor generates a control signal to prevent reception of calls through the public switched telephone network when the wireless communications unit is activated”. Bultman teaches that the processor generates a control signal to prevent reception of calls through the public switched telephone network when the wireless communications unit is activated (abstract; col.1, lines 27-37). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wenk in view of Norman to incorporate the processor generating a control

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signal to prevent reception of calls through the public switched telephone network when the wireless communications unit is activated as taught by Bultman. The motivation for the modification is to have doing so in order to provide a choice to receive calls through a wireless communications unit.

12. Claim 142 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wenk et al. in view of Norman et al. further in view of Parrott et al. (U.S. Patent No. 6,618,580).

Regarding claim 142, Wenk in view of Norman does not specifically teach “a USB port coupled to the removable storage medium for transferring said information to the reader”. Parrott teaches a USB port coupled to the removable storage medium for transferring said information to the reader (col.7, lines 32-35). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wenk in view of Norman to incorporate a USB port coupled to the removable storage medium for transferring the information to the reader as taught by Parrott. The motivation for the modification is to have doing so in order to attach the card with computer using a USB port.

13. Claim 145 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wenk et al. in view of Norman et al. further in view of McGregor et al. (U.S. Patent No 5,577,100).

Regarding claim 145, Wenk in view of Norman does not specifically teach “the processor places the wireless communications unit in call monitoring mode after receiving a confirmation

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signal from the wireless service provider, the confirmation signal received in response to the notification signal”. McGregor teaches this limitation (col.12, line 67, col.13, lines 1-4). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wenk in view of Norman to incorporate the processor placing the wireless communications unit in call monitoring mode after receiving a confirmation signal from the wireless service provider, the confirmation signal received in response to the notification signal as taught by McGregor. The motivation for the modification is to have doing so in order to bill the user at a later time.

14. Claims 146, 147, 151, 152, 159 and 163 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wenk et al. in view of Tayloe (U.S. Patent No 5,933,785).

Regarding claims 146 and 151, Wenk does not specifically teach “the processor resets the wireless communications unit to receive calls based on a mobile telephone number of a third wireless communication unit of a new user, after the removable storage medium is replaced with a removable storage medium containing the new user's mobile telephone number”. Tayloe teaches this limitation (col.6, lines 39-57). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wenk to incorporate the processor resetting the wireless communications unit to receive calls based on a mobile telephone number of a third wireless communication unit of a new user, after the removable storage medium is replaced with a removable storage medium containing the new user's mobile telephone number

as taught by Tayloe. The motivation for the modification is to have doing so in order to register new numbers from the new SIM card after removal of the old one.

Regarding claims 147 and 152, Wenk does not specifically teach that the processor transmits a message to the wireless service provider to prevent the wireless communications unit from receiving calls from any number different from the new user's telephone number. Tayloe teaches this limitation (col.6, lines 39-57). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wenk to incorporate the processor transmitting a message to the wireless service provider to prevent the wireless communications unit from receiving calls from any number different from the new user's telephone number as taught by Tayloe. The motivation for the modification is to have doing so in order to un-register old numbers from the wireless unit.

Claims 159 and 163 are rejected for the same reasons as discussed above with respect to claims 107 and 146.

15. Claims 148-150 and 153-155 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wenk et al. in view of Tsukamoto et al. (U.S. Patent No 5,128,981).

Regarding claims 148 and 153, Wenk does not specifically teach “the processor automatically prevents the wireless communications unit from receiving calls corresponding to the mobile telephone number of the user’s second wireless communications unit based on time-

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of-activation information entered by the user". Tsukamoto teaches this limitation (col.4, lines 25-29, col.20, lines 58-68). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wenk to incorporate the processor automatically preventing the wireless communications unit from receiving calls corresponding to the mobile telephone number of the user's second wireless communications unit based on time-of-activation information entered by the user as taught by Tsukamoto. The motivation for the modification is to have doing so in order to restrict unwanted calls during a specific period of time.

Regarding claims 149 and 154, Wenk does not specifically teach that the time-of-activation information indicates a period of time, and wherein the processor counts down the period of time while the wireless communications unit is set in a call monitoring mode to receive calls based on the mobile telephone number of the user's second wireless communications unit. Tsukamoto teaches this limitation (col.4, lines 25-29, col.20, lines 58-68, col.21, lines 4-8). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wenk to incorporate the time-of-activation information indicating a period of time, and wherein the processor counts down the period of time while the wireless communications unit is set in a call monitoring mode to receive calls based on the mobile telephone number of the user's second wireless communications unit as taught by Tsukamoto. The motivation for the modification is to have doing so in order to receive calls allowed for a particular time duration.

Regarding claims 150 and 155, Wenk does not specifically teach that the time-of-activation information is set by the user through operation of the keypad of the hard-wired telephone. Tsukamoto teaches that the time-of-activation information is set by the user through operation of the execution key [i.e., keypad] of the hard-wired telephone (fig.7; col.12, lines 56-62, col.13, lines 3-31). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wenk to incorporate the time-of-activation information being set by the user through operation of the keypad of the hard-wired telephone in order to prepare different events for selected schedules.

16. Claims 167 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wenk et al. in view of Norman et al. further in view of Tayloe (U.S. Patent No 5,933,785).

Claim 167 is rejected for the same reasons as discussed above with respect to claim 159.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Roberts et al. (US 6,208,854) teach System and method for routing a call to a called party's landline or wireless communication unit.

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ME

MD SHAFIUL ALAM ELAHEE

October 14, 2006

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